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IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

ALFRED H. FAULKNER,

Petitioner,

vs.

BALDWIN PIANO & ORGAN CO., CHICAGO MUSICAL INSTRUMENT CO. et al., THE WURLITZER COMPANY et al., HAMMOND CORP. et al., and L & G ENTERPRISES, INC.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Introduction

Respondents respectfully submit that the Petition sets forth no special or important matter warranting review by this Court.

Petitioner has attempted to invoke Supreme Court Rule 19 on account of alleged conflicts in the circuits or between the Seventh Circuit Court of Appeals and this Court. No such conflicts exist.

Moreover, the present case is an ordinary patent infringement action, involving a dispute between private parties, exceptional only in that Petitioner delayed any assertion of his rights until the waning years of his patent. The sole patent in suit expired October 29, 1974. There has been no other litigation of this patent. The questions raised by Petitioner involve only the private interests of the litigants, and there is no question of widespread or general public interest whatsoever.

The action was resolved favorably to the Respondents by the District Court after 35 days of trial directed to laches and estoppel issues and after a subsequent and alternative Motion for Summary Judgment directed to the merits of Petitioner's patent. The District Court issued a comprehensive opinion that included 219 findings of fact and 16 conclusions of law. This resolution was affirmed by the Seventh Circuit Court of Appeals in a unanimous opinion written by Judge Cummings.*

The Petition does nothing more than argue for yet another level of appeal, seeking a *de novo* review of the scope and validity of the patent in suit, in the hope that this Court will reach a different conclusion than the District Court and Court of Appeals. Chief Justice Taft in *Magnum Co. v. Coty*, 262 U.S. 159, 163 (1923), appropriately stated:

> The jurisdiction [of the Supreme Court to review cases by way of certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing.

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* The appellate opinion found it unnecessary to reach the alternative basis for the District Court's judgment in favor of Respondents, namely, the adjudication after trial of the issues of laches and estoppel.

Counterstatement of Questions Presented

The "Questions Presented" by Petitioner reflect gross misconstructions of the record. The essential issues on which Petitioner seeks this Court's intervention may be properly stated as:

(1) Is it a denial of due process to grant summary judgment of non-infringement or invalidity of Petitioner's patent as a matter of law when such judgment happened to be preceded by a bench trial of laches and estoppel issues, when such bench trial was affirmatively sought by Petitioner himself, and when Petitioner waived any possible claim to a jury trial of the laches and estoppel issues?

(2) Is reading a patent claim in the light of the patent specifications, *U.S. v. Adams*, 383 U.S. 39, 49 (1966), an impermissible attempt to limit the claim, or is it instead a proper means for interpreting the claim as a matter of law?

(3) Is summary judgment of non-infringement or invalidity proper in a patent infringement case, despite a request for jury trial of those issues, when there are no genuine factual issues to be resolved by a jury and when Petitioner belatedly asserted an alleged existence of the possibility of a fact inference favorable to his view of the case?

(4) Should this Court review the Court of Appeals' unanimous affirmance of the District Court's application of the unambiguous and consistently construed holding in *Muncie Gear v. Outboard, Marine & Mfg. Co.*, 315 U.S. 759 (1941), to the effect that a patentee may not achieve indirectly by amendment of claims what could not have been achieved directly with a new application, namely, patent coverage of a device in "public use" more than a year prior to the amendment?

Supplemental Statement of the Case

Petitioner's argumentative statement of the case distorts, omits, and inadequately sets forth the relevant facts. For the sake of brevity, but consistent with providing this Court with an accurate version of the proceedings below, Respondents will expose only the most glaring of Petitioner's distortions.

The Court of Appeals aptly describes the patented subject matter and accurately relates the circumstances underlying application of the *Muncie Gear* "late claiming" doctrine to this case (App. 2a-13a). Respondents need not, therefore, repeat here the technological aspects of the case or the circumstances surrounding "prior use" of Petitioner's alleged invention.

Petitioner's patent-in-suit issued on October 29, 1957, from an application filed March 3, 1951, and relates to circuitry utilized in electronic musical organs. The present case is a typical patent infringement action, extraordinary only in that Petitioner delayed until after virtually the entire electronic organ industry openly adopted the accused circuitry before filing suit against the alleged infringers in 1973.

Each of the Respondents asserted the affirmative defenses of laches and estoppel against Petitioner's belated suits, which were consolidated for discovery and trial before Judge Will. Petitioner correctly notes that it was his own suggestion at an initial pretrial conference that "a separate and prior trial of the affirmative defenses of laches and estoppel be had under Rule 42

F.R.Civ.Proc." (Pet. p. 5). However, Petitioner neglects to reveal that he himself conceded from the very inception that this trial would be a bench trial, despite his request for a jury on the ultimate merits. Thus, at the pretrial conference, Petitioner's counsel produced a written "Motion for Separate and Prior Trial Under Rule 42(b) F.R.C.P.". Significantly, this Motion stated:

> The affirmative related defenses of "laches", "acquiescence" and "estoppel" are matters in equity that are to be decided by a judge.*

The formal filing of this Motion by Petitioner was rendered moot by the agreement of all parties, including Petitioner and the Court, to the separate, initial bench-trial on the issues of laches and estoppel as requested by Petitioner. Reference to the Motion requesting this separate non-jury trial appears in a "Statement of Proceedings Submitted Pursuant to Rule 10(c) F.R.A.P.", which reads in part:

> 4. Based upon Mr. Lettvin's [Petitioner's Counsel] request and the agreement of Defense Counsel, Judge Will agreed to hold such a separate non-jury trial. . . (SA 177)**

All of the parties thereafter conducted themselves in accordance with the understanding reached at this pretrial conference and prepared for a non-jury trial on the issues of laches and estoppel. However, during subsequent discovery, key facts were brought out which proved the incredibility of Petitioner's asserted "lack of knowledge" defense on the issues of laches and estoppel.

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* The Motion in question is attached as Exhibit C to a "Response to Appellant's Motion for Order to Remove and Excise Materials". The aforesaid "Appellant's Motion" was expressly *denied* by the Court of Appeals (footnote at App. 17a).

** The notation "SA" refers to the Defendant's Appendix Accompanying Brief of Defendant-Appellees filed with the Court of Appeals.

Consequently, Petitioner moved to strike the laches defenses of the Respondents (CA 92-6)* on the basis that as a matter of law laches and estoppel defenses are not applicable to a patent infringement action. Even then, Petitioner did not maintain that he was being deprived of a jury trial.

Before proceeding with the hearing of evidence at the initial bench trial on June 26, 1973, the District Court specifically considered and denied Petitioner's pretrial motion to strike the Respondents' laches defense (CA 109-13). Without further objection, Petitioner proceeded with the bench trial at that first hearing. His participation was complete, and Petitioner at no time complained of any alleged denial of a jury trial. However, the hearings initiated on June 26, 1973 were recessed on June 27, 1973 by the District Court because the Court recognized the necessity of the parties' engaging in further discovery and completing a Pre-Trial Order before resumption of trial in order to conserve judicial time.

Significantly, in the process of terminating the initial abortive hearing on laches and estoppel, the District Court announced an intention upon resumption of trial to proceed with the whole case without an initial separation of issues, despite the previously outlined wishes of all parties (Petitioner, Respondents, and the Court itself) to try laches and estoppel on a threshold basis by bench trial. Respondents asked whether the Court would reconsider and entertain a joint request for a preliminary bench hearing on the question of laches and estoppel (CA 144). In the colloquy which followed, the Court was reminded that a composite trial would be

* The notation "CA" refers to the Common Appendix filed with the Court of Appeals.

complicated by the Court's necessity to decide the equitable defenses of laches and estoppel (factually and legally) and by the jury's necessity to decide the ultimate factual merits, if anything factual remained to be decided (CA 145).

In this context, counsel for one of the Respondents stated:

> The plaintiff has waived a jury demand as far as the laches issue is concerned (CA 146).

Petitioner's counsel voiced no objection and acquiesced in this self-evident proposition. As a matter of fact, Petitioner's counsel, referring to the possibility of an adverse ruling on the issues of laches and estoppel, stated:

> Your Honor, your evaluation and analysis of the alternatives available to you, pointed out that there is only one alternative that would take it [*i.e.*, the ultimate merits] away from the jury (CA 147).

The District court thereafter stated as follows:

> That is why I concluded a half hour or more ago that there wasn't any sense to having a separate trial on the issues of validity and infringement from the trial on the issues of laches, until [one of the defendants' counsel] pointed out that the issue of laches was going to be tried necessarily by the Court, but the issues of validity and infringement were going to be tried in this case by the jury.
>
> Well, that is a different ball game. I don't know where that leaves me. I would have to scratch my head about it a little bit, but it does seem to me if I try the issue of laches properly, I am going to get an awful lot of evidence which is also relevant to validity and infringement, and which is going to have to be presented over again at a subsequent trial if I don't conclude that laches or estoppel, or both, or in part at least, are applicable to the plaintiff (CA 152-3).

Thereafter, Petitioner's counsel specifically admitted:

> I agree with the court that the decision on laches and estoppel, the ultimate decision, is the court's only and not the jury's (CA 153-4).

Obviously, Petitioner still was not asserting that he was being denied any right to a jury trial.

As noted by Petitioner, the District Court ultimately reconsidered and adhered to the original approach of a separate laches and estoppel bench trial (Pet. p. 6), but still Petitioner did not contend that any right to a jury trial was being abrogated. The laches and estoppel trial commenced on June 3, 1974, continued intermittently for 35 days through November 6, 1974, and involved 24 witnesses and hundreds of documentary and physical exhibits. Following the conclusion of this extended trial, Respondents filed a timely Motion for Summary Judgment on the ground that uncontested facts established the invalidity of Petitioner's patent. Briefs on the issues of laches and estoppel and on the alternative issues of summary judgment were filed by both sides. No mention was ever made by Petitioner of having been denied a jury trial on the issues tried by the Court.

Subsequently the District Court entered a judgment for Respondents on the issues of laches and estoppel as well as on certain (but not all) issues raised in the Motion for Summary Judgment. The District Court entered 219 findings of fact and 16 conclusions of law, together with a comprehensive opinion (189 U.S.P.Q. 695-732) granting summary judgment and holding that Petitioner's complaint must be dismissed with prejudice and with costs to Respondents. The District Court also found Petitioner guilty of laches and estoppel for his failure to assert his rights against anyone for almost fifteen (15) years. In its conclusions of law, the Court held that summary judgment was appropriate on

certain validity issues as to Claims 1, 12, and 13 of the patent in suit "since the prior art, history of the prosecution of the application leading to the issuance of the patent and the patent itself are all documents capable of interpretation upon examination and all other facts relevant to validity are undisputed" (189 U.S.P.Q. at 716). The gist of these rulings was that Petitioner's patent claims had to be limited to glow tube keyers (not used by any Respondents) in order to preserve their validity.

The District Court held that Claim 1, if interpreted to cover more than glow tube keyers, would be invalid under the "late claiming" doctrine of *Muncie Gear Works, Inc., v. Outboard Marine & Manufacturing Co.*, 315 U.S. 759 (1941). Analogously, the District Court determined that Claims 12 and 13, like Claim 1, must be construed as limited to glow tube keyers because of the patent specification, file wrapper history, and the provisions of 35 U.S.C. § 121 and C.F.R. § 1.141.

Respondents had sought summary judgment of invalidity precisely because Petitioner had sought to expand his patent to cover more than glow tube keyers. The District Court agreed that such expansion would invalidate each of Claims 1, 12, and 13 (for differing reasons, in part, as to Claim 1 versus Claims 12 and 13), and thus ruled in the alternative that the claims were valid, but not infringed, if read narrowly and invalid if read broadly. This was not a *sua sponte* ruling on bases not requested. To the contrary, it was a precise recognition of the very grounds of invalidity asserted by Respondents. The alternative of limiting the claims to avoid infringement was merely an inherently logical extension of Respondents' position regarding invalidity.

Petitioner urged before the Court of Appeals the same issue of denial of a jury trial that he urges in his Petition. Respondents answered before the Court of Appeals (1) that Petitioner was not entitled to a jury trial on the equitable issues of laches and estoppel and had in any event waived any claim to a jury trial by his own initiation of and participation in a bench trial of those issues, and (2) that Petitioner was not entitled to a jury trial on the merits of his patent because there were no factual issues to be determined by a jury. The Court of Appeals ruled that "[b]ecause summary judgment was proper on this record, there was no need for the district court to hold a jury trial as to the validity of plaintiff's patent" (App. 4a). In view of this affirming ruling, there was no need to "reach the other questions decided by Judge Will" (App. 4a).

ARGUMENT

REASONS FOR DENYING THE WRIT

I. AS TO THE FIRST AND THIRD QUESTIONS

Petitioner's First and Third Questions are essentially two sides of the same coin. In posing his First Question, Petitioner erroneously contends that he was denied due process and improperly denied a jury trial of legal issues by the District Court's granting, and the Court of Appeals' affirmance, of summary judgment in Respondents' favor. Petitioner's Third Question simply raises the same issue from a different perspective, arguing that the award of summary judgment was improper because there was a fact question as to whether the possibility of an inference favorable to Petitioner's view of the case exists. Because these two questions are inextricably intertwined, Respondents will treat them together.

In posing his First Question, Petitioner erroneously contends that affirmance of summary judgment by the Court of Appeals constitutes a direct conflict with the decisions by this Court in *Beacon Theatres v. Westover*, 359 U.S. 500 (1960), and *Dairy Queen v. Wood*, 369 U.S. 469 (1962). Petitioner is fundamentally wrong. He is seeking only to create a basis for further appellate review by arguing that there is a "conflict" when, in reality, no such conflict exists.

Petitioner correctly notes that *Beacon Theatres* and *Dairy Queen* stand for the proposition that a right to a jury trial of legal issues cannot be lost through a prior determination of equitable issues (Pet. p. 11). However, Petitioner has not lost any "right" to a jury trial by the

District Court's determination of the equitable defenses of laches and estoppel. Simply stated, Petitioner is not entitled to a jury trial of the non-infringement or invalidity issues because of the absence of any genuine factual issues to be resolved by the jury, and not because of the District Court's determination of the alternative laches and estoppel issues. In short, Petitioner was not entitled to a jury trial regarding non-infringement and invalidity regardless of whether the laches and estoppel issues were decided, regardless of by whom they were decided, and regardless of how they were decided.

Moreover, neither *Beacon Theatres* nor *Dairy Queen* involved a motion for summary judgment and thus are not controlling. Petitioner's criticism notwithstanding (Pet. pp. 12-3), the Court of Appeals obviously recognized that no useful purpose would be served by citing or discussing these Supreme Court decisions because their rationale is inapplicable to the factual circumstances and procedural history of the instant case.

It has long been settled that the grant of summary judgment does not infringe a party's constitutional right to a trial by jury. *Fidelity & Deposit Co. v. United States*, 187 U.S. 315, 320 (1902). In *King v. United Benefit Fire Insurance Company*, 377 F.2d 728, 731 (10th. Cir. 1967), the Court stated the rule clearly as follows:

> It is firmly established that the granting of a motion for summary judgment or directed verdict in an appropriate case does not infringe upon the right to trial by jury.

The record discloses that the District Court construed and interpreted Petitioner's patent *as a matter of law* based on *uncontroverted facts*—a procedure entirely consonant with the Seventh Amendment and with the

provisions of Rule 39(a), F.R.Civ.P.* As aptly stated by Mr. Justice Brandeis in *Ex Parte Peterson*, 253 U.S. 300, 310 (1920):

> No one is entitled in a civil case to trial by jury unless and except so far as there are issues of fact to be determined.

The case of *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Sup. Co.*, 332 F.2d 406 (6th Cir. 1964), is pertinent in view of Petitioner's misguided reliance upon the *Beacon Theatres* and *Dairy Queen* decisions. Defendant's motion to strike the plaintiff's jury demand therein was granted by the District Court. The District Court subsequently held both patents invalid. 204 F.Supp. 249 (W.D. Tenn. 1961). Plaintiff appealed and the Court of Appeals vacated the judgment and remanded the case for reconsideration in light of the *Dairy Queen* case, which had just been decided by this Court. See 305 F.2d 375 (6th Cir. 1962). On remand, the District Court held that the patents were invalid as a matter of law in view of the undisputed evidence and that therefore no prejudice accrued to the plaintiff in striking the demand for a jury trial, 214 F.Supp. 704 (W.D. Tenn. 1963).** The Court of Appeals affirmed:

> Throughout our disposition of this case we have not been unmindful of plaintiff's right to a jury trial. We are of the opinion, however, that the facts were

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* Rule 39(a) specifically provides that when a trial by jury has been demanded, the trial of all issues so demanded shall be by jury in the absence of stipulation or unless ". . . the court upon motion or of its own initiative finds that a right of trial by jury of some or all of those issues does not exist . . ."

** The Court concluded, *inter alia*, that the claims were invalid on the authority of *Muncie Gear, supra*, and that "no factual dispute needed resolution for the court to conclude as a matter of law that the three claims herein were invalid," 214 F.Supp. at 706-7.

clearly established and that there were no factual issues to be resolved by a jury. Therefore plaintiff was not prejudiced by the denial of a jury trial. (332 F.2d at 417)*

Plaintiff's subsequent petition for writ of certiorari was denied by this Court, 379 U.S. 888 (1964). The perceptive rationale of the *Monroe* case is dispositive of the First Question advanced by Petitioner.

In the instant case, Petitioner requested a preliminary non-jury trial on the issues of laches and estoppel. The Respondents agreed, the trial was held, and the decision was unfavorable to the Petitioner. Prior to this decision, Respondents also moved in the alternative for summary judgment. At the same time the laches and estoppel issues were decided adversely to Petitioner, the alternative of summary judgment was granted by the District Court after determining that there were no disputed questions as to any material facts.** Petitioner now asserts he was denied his constitutional right to a jury trial. It is undisputed, however, that he himself requested a non-jury trial on the laches and estoppel issues resolved against him, and he simply was not entitled to a jury trial as to the non-infringement and invalidity issues decided against him because no disputed fact questions existed as to those issues.

There is yet another compelling reason why disposition of the present case by summary judgment does not

* This rationale has been followed in a number of cogent decisions, most notably, *National Life Insurance Company v. Silverman*, 454 F.2d 899 (D.C. Cir. 1971), and *Webster v. Offshore Food Service, Inc.*, 434 F.2d 1191 (5th Cir. 1970).

** Summary judgment was denied as to other grounds (e.g., prior art) asserted by Respondents because the District Court concluded that factual issues existed as to these other grounds.

conflict either directly or in principle with the *Beacon Theatres* and *Dairy Queen* decisions. This Court properly recognized in those cases that the District Court had attempted *sua sponte* to usurp and foreclose the right to trial by jury by imposing upon the party seeking such a trial a preliminary non-jury trial on equitable issues. Unlike *Beacon Theatres* and *Dairy Queen*, the present case is one in which an extensive separate trial on the laches and estoppel issues resulted, not from the District Court's *sua sponte* action, but rather from a *request initiated by Petitioner himself.* Accordingly, the guiding principles or motivating factors underlying *Beacon Theatres* and *Dairy Queen* are wholly absent here.*

Petitioner's Third Question takes a slightly different tack as to whether the Court of Appeals erred in affirming the action of the District Court with respect to Respondents' Motion for Summary Judgment. Petitioner argues that the decisions below conflict with this Court's decision in *Adickes v. Kress & Co.*, 398 U.S. 144 (1970).

The *Adickes* case involved a conspiracy count in a civil rights case, in which the respondent, in moving for summary judgment, had failed to foreclose the possibility, asserted by the petitioner, that there was a policeman in the respondent's store when the petitioner was denied

* In this case, the decision of the District Court on the issue of non-infringement was not raised *sua sponte*, as erroneously asserted by Petitioner (Pet. p. 14). The District Court, in construing the asserted claims of the patent in suit as being limited to glow tube keyers in order to preserve their validity, simply held as a matter of law and in the alternative that there was no infringement, since Petitioner had already admitted that none of the accused devices utilized a glow tube keyer of any type. This was merely an inherently logical extension of Respondents' position regarding invalidity of Petitioner's claims if interpreted to embrace more than just glow tube keyers.

service. The petitioner had contended that the policeman reached an understanding with some employee of the respondent to the effect that the petitioner not be served. Clearly, there was a fact issue to be resolved.

The record below in the instant patent infringement case is an entirely different matter. As correctly determined by the District Court and affirmed by the Court of Appeals:

> There are no issues of fact material to the issue of validity which are in dispute since the prior art, history of the prosecution of the application leading to the issuance of the patent and the patent itself are all documents capable of interpretation upon examination and all other facts relevant to validity are undisputed. (189 U.S.P.Q. at 716; App. 3a)*

Petitioner here argues that the "non-foreclosed possibilities" which precluded summary judgment were (1) that the 1955 Lowrey Model SS had *only* AC keying and no DC keying, and (2) that this Lowrey model was only

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* The District Court was fully aware of its limitations in light of Petitioner's request for a jury trial:

> It is fundamental that the defense of invalidity, as well as those of laches and estoppel, is an affirmative defense, and the burden of proof with respect thereto rests on defendants. In addition, the validity of patent claims, like the issue of laches and estoppel, is a question of law and the fact that plaintiff is seeking a jury trial does not affect the appropriateness of summary judgment if there are no disputed material facts. *Research Corp. v. Nasco Industries, Inc.*, 501 F.2d 358, 182 U.S.P.Q. 449 (7th Cir. 1974); *Armour & Co. v. Wilson & Co.*, 274 F.2d 143, 124 U.S.P.Q. 115 (7th Cir. 1960). It is also fundamental that summary judgment under Rule 56 of the Federal Rules of Civil Procedure may be granted only if there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. (189 U.S.P.Q. at 717)

"experimental" and therefore incapable of "public use" (Pet. p. 20). But to so argue is to ignore the record in an effort to fabricate an appealable issue.

Respondents affirmatively proved at the laches and estoppel trial by the unchallenged testimony of Walter J. Anderson, Lowrey's chief engineer and the designer of the Model SS, that the 1955 Lowrey Model SS had both DC and AC keying. Indeed, Petitioner himself recognized this when he charged the Model SS with infringement on account of its DC keying (App. 11a). This unrefuted evidence from Anderson, coupled with Petitioner's own accusation of infringement as to the Model SS, foreclosed the possibility of a fact question concerning the presence of DC keying in the Model SS. Petitioner never challenged this conclusion until appeal when he urged an allegedly contrary inference that could be derived from a report by Young, a Hammond engineer. The Court of Appeals carefully reviewed Petitioner's contention and found that an "*apparent* inconsistency" between Anderson's testimony and the Young documentary evidence belatedly seized upon by Petitioner was not an *actual* inconsistency. Thus, the Court concluded that no disputed fact or "non-foreclosed possibility" actually existed (App. 9a-11a).

Moreover, the Court of Appeals ruled that Petitioner's contention regarding the Young report even if sound was "[i]n any event" waived by Petitioner's failure to raise the issue before the District Court pursuant to Rule 56(e) F.R.Civ.P. (App. 11a). This failure is in marked contrast to the situation in *Adickes* where the petitioner "in opposing summary judgment" expressly relied upon and pointed to matters of record that "creat[ed] an issue of fact as to what [respondent's]

motives might have been in ordering the refusal of service" (398 U.S. at 156-7).*

The Court of Appeals in this case obviously recognized this crucial distinction from the *Adickes* situation for, as noted by Petitioner, *Adickes* was urged twice and rejected (Pet. p. 19). Aside from lack of merit, Petitioner's contention regarding the Young report as a "non-foreclosed possibility" was simply waived because it was not raised in opposition to the motion for summary judgment as required by the *Adickes* interpretation of Rule 56 F.R.Civ.P.

Similarly, the Court of Appeals expressly considered and rejected the Petitioner's fall back argument concerning an alleged second "non-foreclosed possibility", *i.e.*, that the Model SS was "experimental":

> The public exhibit and demonstration of the Lowrey Model SS at the Chicago show, regardless of a Hammond Organ employee's description of it as experimental, satisfies the term "public use" as used in *Muncie Gear* and 35 U.S.C. § 102(b). *Cloud v. Standard Packaging Corp.*, 376 F.2d 384, 389-390 (7th Cir. 1967). (App. 13a).

Petitioner misconstrues the import of the Court of Appeals' decision, arguing that the Court recognized that "non-foreclosed possibilities" existed, but incorrectly held that it was Petitioner's burden to offer affirmative evidence on the issue to stave off summary judgment (Pet. p. 21). But Petitioner is wrong. The Court of Appeals specifically held that there were no "nonforeclosed possibilities" and that in any event Petitioner had waived his opportunity to claim otherwise because of his belated contentions. In short, since Petitioner did not establish before the District Court any dispute concerning a material fact in opposition to the motion, summary judgment was proper.

* Notably, Petitioner has failed to mention that this Court in *Adickes* recognized that the burden shifts to the party opposing a motion for summary judgment when the movant has met the initial burden:

> If respondent had met its initial burden by, for example, submitting affidavits from the policemen denying their presence in the store at the time in question, Rule 56(e) would then have *required petitioner to have done more* than simply rely on the contrary allegation in her complaint. (398 U.S. at 160; emphasis added)

II. AS TO THE SECOND QUESTION

Essentially, Petitioner argues that the Court of Appeals erred, and this Court must intervene, because he believes: (1) there is no statutory basis specified by the Court of Appeals in support of its affirmance of the District Court's finding that Claims 12 and 13 are invalid if read to cover more than the disclosed glow tube electronic keyers; and (2) the Court of Appeals improperly read an element into Claims 12 and 13.* These arguments are specious. Even if supportable, they do not present special or important questions justifying intervention by this Court.

The crux of Petitioner's argument is that the District Court and the Court of Appeals read an element (nowhere identified by Petitioner but obviously intended to be "glow tube keyers") into Claims 12 and 13 (see, *e.g.*, the cases cited at Pet. p. 18). But neither Court read anything into Claims 12 and 13. They simply interpreted

* Claims 1, 12, and 13 of the Faulkner patent are reproduced in the Court of Appeals' decision (App. 9a, 14a). These are the only claims alleged to have been infringed. Petitioner has admitted that Claim 13 is dependent on Claim 12 and that they differ only in that the signal channels of Claim 13 are specified as having different transmission characteristics (App. 14a).

the language of Claims 12 and 13 narrowly in light of the patent specification and accordingly limited the claims to glow tube keyers as disclosed in order to preserve their validity:

> Nowhere in the original application is there any reference to anything other than neon glow tubes as keying devices. Throughout the entire six years' prosecution of the application, only neon glow tubes were disclosed as the electronic keying devices in the patent specifications. (App. 6a)

As held by this Court in *United States v. Adams*, 383 U.S. 39, 49 (1966), it is fundamental that claims must be construed in light of the specification, and both the claims and the specification must be read with a view to ascertaining the invention.* Thus, both the District Court and the Court of Appeals properly read Claims 12 and 13 in the light of the patent specification and held that those claims were limited to glow tube keyers.**

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* Even the cases cited by Petitioner (Pet. p. 18), in an attempt to show that a conflict exists, reaffirm rather than contradict this fundamental tenet of patent law. Thus, in *McCarty v. Lehigh Valley Railroad Co.*, 160 U.S. 110, 118 (1895), this Court held that the invention in suit was "of such limited character as to require a narrow construction." And, in *Maclaren v. B-I-W Group, Inc.*, 535 F.2d 1367, 1372 (2d Cir. 1976), the Second Circuit Court of Appeals held: "This rule does not preclude the court from looking to the specifications and drawings for purposes of understanding and interpreting the claims of the patent." Finally, in *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419 (1907), this Court noted that while the courts may not add to or detract from the claim, they "may construe the same in view of the specifications and the state of the art . . ."

** A "keyer" or "electronic keyer" is simply an electronic switch (App. 6a). As noted above, the only electronic keyer illustrated or described in the Faulkner patent is a neon glow tube keyer. Since the "non-linear conducting device" language in Claim 1 was interpreted by the Court of Appeals to be restricted to neon glow tube keyers, that language in Claim 1

(Footnote continued on following page)

Petitioner made essentially the same argument before the Court of Appeals that he raises in his Petition. But that Court held:

> This argument is blatantly specious and "not in our opinion tenable" (189 USPQ at 726) when viewed in the light of the patent specifications. *United States v. Adams*, 383 U.S. 39, 49. (App. 14a-15a)

The Court of Appeals also offered an additional basis for construing Claims 12 and 13 to cover only glow tube keyers. A construction of "electronic keyer" as used in these claims as being broader than the keyer set forth in Claim 1 would create the anomalous situation in which two separate and distinct inventions are claimed in the same patent. As noted by the Court of Appeals in the portion of the footnote excised by Petitioner in quoting (out of context) that Court's decision at p. 18 of its Petition:

> However, 35 U.S.C. § 121 also provides that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." By way of 37 C.F.R. § 1.141 (35 U.S.C.A. App. 1 at 690), the Commissioner has made this requirement mandatory. Thus if a claim is ambiguous, *i.e.*, capable of being read as an independent and distinct invention or just another claim of one invention, the statute and regulation together create a presumption against reading the claim as an independent and distinct invention. (App. 15a)

Obviously, this ruling is in no way inconsistent with the general proposition relied on by Petitioner (see cases

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** *continued*
cannot be relied on for extending and expanding the meaning of Claims 12 and 13. Recognizing this, the Court of Appeals noted "the term 'electronic keyer' in Claims 12 and 13 does not have a different meaning than the described keyer in Claim 1". (App. 15a)

cited at Pet. p. 15) to the effect that the invalidity of one claim of a patent need not necessarily affect the validity of another.

The Petitioner's Second Question is contrived and not supported by the record. The Court of Appeals did not read any element into Claims 12 and 13; it merely construed them in accordance with the patent specification. Thus, there is no conflict with any decision of this Court. And, the Court of Appeals explicitly cited statutory underpinnings for its finding that Claims 12 and 13 would be invalid if construed broadly. The mere fact that these underpinnings were cited in a footnote* does not render the Court of Appeals' decision "in direct conflict with 35 U.S.C. § 282" as Petitioner suggests.

III. AS TO THE FOURTH QUESTION

The Fourth Question simply inquires as to whether the Courts below correctly construed *Muncie Gear*.

The "late claiming" bar of *Muncie Gear* is summarized correctly by the District Court (189 U.S.P.Q. at 721) and by the Court of Appeals:

> The [Supreme] Court concluded that, since a new application would have been statutorily barred if made more than two [now one] years after the first public use or sale of a device embodying the alleged invention, an amendment seeking to achieve indirectly what could not have been achieved directly, was improper and the patent invalid.** (App. 5a)

* Of course, this statutory basis is also referenced in the main text of the Court of Appeals' decision, in the context of the basis for the District Court's decision expressly affirmed by the Court of Appeals (App. 4a, 14a).

** Petitioner conceded that Claim 1 could *not* be read on the Lowrey Model SS Organ prior to its enlargement by amendment in December, 1956.

The effect of applying *Muncie Gear* to the patent in suit is to limit it to glow tube keyers as a matter of law.* This is appropriate because, as the Court of Appeals held:

> Nowhere in the original application is there any reference to anything other than neon glow tubes as keying devices. Throughout the entire six years' prosecution of the application, only neon glow tubes were disclosed as the electronic keying devices in the patent specifications. (App. 6a)

Petitioner argues that the Court of Appeals misapplied the *Muncie Gear* doctrine to the instant case because the actual application for the patent in suit disclosed more than glow tube keyers. But, both the District Court and Court of Appeals expressly held that the patent in suit discloses only glow tube keyers. Thus, the basis for Petitioner's argument is lacking, and his Fourth Question is specious.**

Petitioner's further reliance on numerous cases cited in his Petition, in an effort to contrive a "conflict" among the circuits and thereby sustain his frivolous Petition, is unavailing. *Engineering Development Lab v. Radio Corp. of America*, 153 F.2d 523 (2d Cir. 1946) (Pet. pp. 23-4), involved a case where the amendments to the claims in dispute were supported by the language of earlier claims pre-dating the alleged prior public use, 153 F.2d at 525-526. *Binks Mfg. Co. v. Ransburg Electro-Coating Corp.*, 281 F.2d 252 (7th Cir. 1960) (Pet. p. 23), involved the claim language "bridging", which the Court

* Significantly, the District Court determined that Petitioner's conduct during the period 1957-72 (before filing suit) corroborated this conclusion. (189 U.S.P.Q. at 724)

** Similarly, the Petitioner's citation of *King-Seeley Thermos Co. v. Refrigerated Dispensers, Inc.*, 354 F.2d 533, 539 (10th Cir. 1965) (Pet. p. 23), is inapposite.

held was inherent in the original disclosure of the patent application. Thus, both cases involved circumstances wholly different from the instant case, where the Court of Appeals held there was no generic or inherent disclosure in the Petitioner's application of a "non-linear conducting device" as claimed in Claim 1.

Petitioner, recognizing that no real conflict exists with any decision of this Court or within the circuits, attempts to generate such a conflict by misconstruing this Court's decision in *Muncie Gear*:

> From the foregoing, it can be seen that the *Muncie Gear* doctrine does not come into operation merely by the amendment of claims, or by the insertion of new claims by amendment, during the course of prosecution of an original patent application. The *Muncie Gear* doctrine comes into play in connection with an original patent application only when the description of the invention is amended subsequent to the critical date established by 35 U.S.C. § 102(b), and when such description then provides a basis of support for claims that are then, or later, also amended or introduced by amendment. (Pet. p. 25)

Thus, Petitioner argues that *Muncie Gear* is a "late specification amending" case, not a "late claiming" case. Such a position is untenable, in view of the numerous cases consistently holding that *Muncie Gear* espouses a "late claiming" doctrine. There is no conflict, for as expressly stated by this Court in *Muncie Gear*:

> The *claims* in question are invalid if there was public use, or sale, of the device which they are *claimed to cover*, more than two years before the *first disclosure thereof to the Patent Office*. (315 U.S. at 768; emphasis added)*

* Indeed, two of the claims struck down in *Muncie Gear* had nothing whatsoever to do with the amendment to the specification. See 315 U.S. at 763.

In any event, such considerations are academic in view of Petitioner's own recognition that claims broadened by amendment after public disclosure escape the proscription of the *Muncie Gear* doctrine only if they "are supported by the original disclosure" (Pet. p. 24). The District Court and the Court of Appeals in this case specifically held that Claim 1 was valid if limited to glow tube keyers—as supported by the original disclosure—but invalid under *Muncie Gear* if expanded to cover more than glow tube keyers—because not supported by the original disclosure.

Thus, no real issue is presented by the Fourth Question of the Petition, since the extant decisions in this case are fully consistent even with Petitioner's arguments.

CONCLUSION

Nowhere in his Petition has Petitioner demonstrated any substantial reason or basis for granting a Writ of Certiorari. Not only has he failed to show that any error occurred in the proceedings below, he has not demonstrated that his case involves any of the considerations governing review on certiorari as outlined in Supreme Court Rule 19. The Petition presents no special or important reason why the Writ should be granted. There is no conflict between the decisions of any Courts of Appeals. There is no Federal question which has been decided in conflict with any decision of this Court. And there has been no departure from the accepted and usual course of judicial proceedings.

Respondents respectfully submit that the Petition is without merit and should be denied.

Respectfully submitted,

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